

## **REMARKS**

### **Status of the Claims**

Claims 11-23 are pending in this application.

Claims 11-23 are rejected.

Claim 23 has been canceled, without prejudice.

### **Rejection of Claim 23 Under 35 U.S.C. § 112 second paragraph**

The Office Action rejected claim 23 under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regarded as the invention. Without admitting or denying the patentability of claim 23, Applicant has elected to cancel claim 23 in an effort to further expedite the prosecution of this case. Therefore, Applicant believes that the rejection under § 112 has now been obviated by the cancellation of claim 23. Removal of the rejection is respectfully requested.

### **Rejection of Claims 11-22 Under 35 U.S.C. § 103**

The remaining claims 11-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,538 issued to Schultz (hereafter Schultz) in view of U.S. Patent No. 5,820,245 issued to Desmond, et al. (hereafter Desmond). The Office Action indicated that Schultz discloses all the limitations of the claims except:

- a mirror housing of an automotive interior mirror module (as recited in Claim 11);
- the sensor being disposed in the mirror housing (as recited in Claim 11);
- the electronic unit being disposed in the mirror housing (as recited in Claim 11)

a reading lamp (as recited in Claim 13);  
the lamp being integrated in the housing (as recited in Claim 13);  
the lamp being turned on and off by the turn-on and turn-off signals (as recited in Claim 13);  
the automotive interior mirror module having a mirror base (as recited Claim 14);  
the electronic unit being located in the mirror base (as recited in Claim 15);  
the electronic unit being an external unit located (as recited in Claim 16);  
the external unit being located externally from the mirror housing or the mirror base (as recited in Claim 16);  
the electronics unit being located in the housing (as recited in Claim 17);  
the sensor being a sensor array (as recited in Claim 18);  
the sensor being located in the lower corner region of the housing facing a driver (As recited in Claim 22); and  
the sensitive area of the sensor being at least ten times the size of a conventional mechanical push button (as recited in Claim 23).

The Office Action relied upon Desmond to disclose some of the limitations indicating that “[i]t would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the non-contact switch of SHULTZ and the vehicle illumination device of DESMOND et al. to equip such illumination device with a switch capable of being operated by the approaching hand of a user, as per the teachings of SCHULTZ (See Column 2, Lines 24-29).” Applicant respectfully disagrees with the argument that it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to combine the non-contact switch of Schultz and the vehicle illumination device of Desmond since there is no motivation to combine these references.

Applicant recognizes the argument pertaining to the adequacy of the proposed combination of references was made in the last response to Office Action. The present Office Action responded to Applicant’s previous argument stating that:

in response to Applicants argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re fine*, 837 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case SCHULZ discloses a proximity actuated switching circuit, using such switching circuit as the switch of DESMOND et al. would have flown naturally to one of ordinary skill in the art as detailed in Section 3 of the instant Office Action.

See present Office Action mailed February 17, 2005 ¶ 14. Thus, the present Office Action apparently concedes that there is no teaching, suggestion or motivation to combine Schulz and Desmond, but rather the obviousness argument relies upon the knowledge generally available to one of ordinary skill in the art. Applicant respectfully disagrees with the Examiner's basis for the obviousness rejection and maintains that there must be some sort of motivation or suggestion in the references themselves, or other extrinsic evidence which would make the purposed combination of references possible.

The Office Action relied upon the Federal Circuit's decision in *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) for the notion that a combination of references can be proposed based upon the knowledge generally available to one skilled in the art. However, a review of the decision in *In re Fine* suggests that the reference still must contain some evidence. The court stated "[t]he primary basis for the Board's affirmance of the Examiner's rejection was that it would have been obvious to substitute the Warnick nitric oxide Detector for the Eads sulfur dioxide detector in the Eads system. The Board reiterated the Examiner's bald assertion that 'substitution of one type of detector for another in the system of Eads would have been within the skill of the art,' but neither of them offered any support or explanation of this conclusion." *In re Fine*

837 F.2d 1071, 1074 (Fed. Cir. 1988). The court further noted that “[t]he East and Warnick references disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be ‘obvious to try’ is not a legitimate test of patentability.” *Id.* at 1074 [citations omitted]. The opinion went on further stating that “[i]nstead, the Examiner relies on hindsight in reaching his obviousness determination. But this court has said, ‘to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’” *Id.* at 1074-1075 [citations omitted]. It is respectfully submitted that the rejection in the present case is spawned from the improper use of hindsight and there is no teaching, suggestion or motivation for the combination set forth by the Examiner.

Applicant also wishes to draw the Examiners attention to the Federal Circuit’s decision in the case of *In re Fritch*, 23 USPQ 2d 1780 (Fed. Cir. 1992). The court in the *Fritch* decision was faced with the issue of determining whether the Board of Patent Appeals erred in affirming the Examiner’s determination that the prior art references of Wilson and Hendrix rendered the subject matter of *Fritch*’s independent claims obvious. *Id.* at 1781. The invention in *Fritch* focused on a landscape edging device that included a planar base portion and an upwardly extending retaining portion. The Examiner cited the Wilson patent which described a graphed edging and watering device in combination with the Hendricks patent which defined a loose material retaining strip for gravel and other particles. *Id.* at 1782. The applicant and court focused on the feature of the *Fritch* invention wherein it was claimed that the entire edging device was flexible to conform to the natural contours of the ground upon which it would be setting. *Fritch* attacked the Board of Patent Appeals indicated that the proposed combination of

Application No. 10/607,923 Page 8

references contained no teaching, suggestion, or incentive to be modified or combined. The court agreed. *Id* at 1783. The court stated that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* at 1783 [citations omitted].. The court went on to hold that the Examiner impermissibly used hindsight to arrive at the determination of obviousness. *Id* at 1783-1784. The court stated “it is impermissible to use the claimed invention as an instruction manual ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *Id.* at 1784.

In the present case the Examiners combination of Shultz in view of Desmond falls short of rendering the claims obvious since there is no teaching, suggestion or motivation to combine the two references. Without such suggestion the rejection is based upon impermissible hindsight. This is not permissible according to the federal circuit's decisions in *In re Fine* and *In re Fritch*. The previous response to Office Action indicated that Schultz describes a switching device for exterior automotive applications such as door handles and windshield wipers. There is nothing in the specification of Schultz that teaches or suggests the switch member as being used to operate a light source or an interior mirror, or being in the interior of the automobile cabin. Furthermore there is nothing in Schultz that teaches or suggests placing the switch member in the housing of an interior rear view mirror. Desmond describes a rear view mirror housing having a lamp with a manually operated switch member. There is nothing in the Desmond patent that teaches or suggests the switch member operating in any fashion other than manually. Therefore, Applicant maintains that the proposed combination of references does not render the claims as a whole obvious because they lack

suggestion, teachings or motivation, or incentive to be combined for providing the inventive combination of the subject invention. Since Shultz and Desmond are not properly combinable and do not render claim 11 obvious Applicant respectfully requests removal of the rejection of claim 11. Furthermore, claims 12-22 either depend directly or indirectly from independent claim 11, therefore, these claims would also be allowable by virtue of their dependency. Applicant respectfully requests reconsideration and removal of the rejection of these claims and allowance thereof.

The Office Action also rejected claims 15 and 16 which indicate that the evaluation electronics unit is located in the mirror base (claim 15) or external from the mirror housing or mirror base (claim 16). Applicant responds to the rejection of claims 15 and 16 calling to the Examiner's attention the fact that these claims are dependent upon independent claim 11 which Applicant now contends is not rendered obvious. Therefore, Applicant maintains that dependent claims 15 and 16 would be allowable by virtue of their dependency upon independent claim 11. Applicant respectfully requests removal of the rejection of claims 15 and 16 and asks that they be granted allowance.

The Office Action also rejected dependent claim 18 "which defines said at least one sensor" in claim 11 as being "a sensor array." The Office Action stated that:

...[t]he Applicant is advised that it has been held by the courts that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In this case DESMOND et al. discloses a plurality of switches 27 and 29 for controlling the illumination of lamps 63 and 78. Using more than one of the switches of SHULZ to independently control the lamps DESMOND et al. would have flown naturally to one of ordinary skill of the art at the time the invention was made, with such plurality of sensors broadly considered a 'sensor array'.

Applicant respectfully traverses the rejection of claim 18 under § 103. First Applicant wishes to note that claim 18 is dependent upon independent claim 11 to which Applicant has already presented arguments traversing the obviousness rejection with regard to

independent claim 11. Applicant believes that claim 18 would be allowable by virtue of its dependency on independent claim 11. However, Applicant also wishes to further point out that Schulz in view of Desmond is not a plausible combination that renders dependent claim 18 obvious. Applicant's reasoning for this is nearly identical to the reasoning set forth with respect to claim 11. That is the combination of Schulz in view of Desmond does not render the subject invention obvious since there is no teaching or suggestion that would suggest or motivate one skilled in the art to combine these references in a manner which would provide this inventive features of claim 18. Without such a teaching or suggestion it is respectfully submitted that the Examiner is improperly using hindsight in suggesting the proposed combination. Furthermore Applicant wishes to note that Desmond only discloses two manually operated push-button switches for controlling lamps. Applicant does not believe that a patent showing two manual push-button switches, would teach or suggest to one of ordinary skill in the art that it would be an obvious to replace these manual switches with a complex non-contact switch such as a sensor array. Therefore, Applicant respectfully requests removal of the rejection of dependent claim 18 and allowance thereof.

### **CONCLUSION**

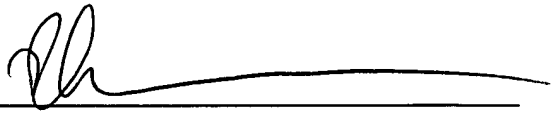
It is respectfully submitted that in view of the above amendments and remarks claims 11-23, as presented, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, Applicant submits that the pending claims are properly allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the Applicant's undersigned attorney at  
(248) 364-4300 if any unresolved matters remain.

Respectfully submitted,

WARN, HOFFMANN, MILLER & LALONE, P.C.  
Attorneys for Applicant(s)

Dated: April 18, 2005

By: 

Philip R. Warn, Reg. No. 32775  
Gregory L. Ozga, Reg. No. 53425

P.O. Box 70098  
Rochester Hills, MI 48307  
(248) 364-4300

PRW:GLO:cah